

REMARKS

The prior office action mailed December 5, 2003 indicated that claims 1-55 were pending in this application. Moreover, the prior Office action indicated that claims 1-11, 19, 22, 32, 34 and 36-50, directed to a method of anchoring and an intermediate anchor system, included allowable subject matter.

The pending office action unreasonably sets forth a restriction requirement between the claims of Group I (claims 1-11 and 36-50, "drawn to a method of anchoring") and Group II (claims 12-35 and 51-55, "drawn to an intermediate anchor system") as distinct from one another.¹ The stated basis provided for the restriction requirement is that the claims of Groups I and II are "related as process and apparatus for its practice." In support of the requirement, the official action cites the general requirements of MPEP §806.05(e) and asserts that that the "inventions are distinct if it can be shown that either: (1) that the process as claimed can be practiced by another materially different apparatus or by hand, or (2) that the apparatus as claimed can be used to practice another and materially different process." In particular, the office action states "the method can be used with an anchor having additional features *than those recited in the apparatus claims* and the anchor can be used by *any means deemed suitable to the user*"

In light of these stated reasons and the remarks set forth below, applicant respectfully requests withdrawal of the pending restriction requirement as improper and unnecessary.

¹ Note: The previously allowed method and apparatus claims now fall into these "distinct" groups.

**I. THE RESTRICTION REQUIREMENT DOES NOT SATISFY THE
MINIMUM CRITERIA SET FORTH IN MPEP §803**

The restriction requirement is legally improper because it does not meet the minimum criteria set forth in MPEP §803. A proper restriction requirement requires two criteria to be satisfied. First, the inventions must be independent or distinct as claimed, such that restriction is proper only if either or both of the following can be shown:

(A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process.

Second, regardless of whether the inventions are independent or distinct, there "must be a *serious burden* on the examiner if restriction is required" (emphasis added). "If the search or examination of an entire application can be made *without serious burden*, the examiner *must examine it on the merits*, even though it includes claims to independent or distinct inventions" (emphasis added).

Applicant respectfully submits that neither criteria for requiring restriction has been satisfied and thus the application must be examined as filed. First, the office action states that "the method can be used with an anchor having additional features *than those recited in the apparatus claims* and the anchor can be used by *any means deemed suitable by the user*. While, these statements may be true, they do not satisfy the legal requirements for requiring restriction as set forth above. In particular, the relevant distinctiveness inquiry is based on the *claimed* method steps and apparatus elements, and not, as asserted in the present action, in the possible steps and elements. If, *arguendo*, the logic set forth in the pending action where true, any two sets of claims could be defined as distinct and restricted simply by asserting that element A

and step B could be added if deemed suitable by the user. For this reason, applicant respectfully submits that the first criterion for requiring restriction has not been satisfied, because the inventions as claimed have not been shown to be distinct.

Moreover, applicant respectfully submits that the second criterion, i.e., that examination would constitute a serious burden, has not been satisfied. In particular, the allowance of method and apparatus claims embodied in claims 1-11, 19, 22, 32, 34 and 36-50, clearly indicates that examination of an entire application can be made without serious burden. In fact, the allowance of these claims in the December 5, 2003 office action irrefutably shows that *examination of these claims has been made without serious burden*. Thus, applicant respectfully inquires where the burden, much less the serious burden, lies in light of the already examined *and allowed* claims 1-11, 19, 22, 32, 34 and 36-50? Applicant acknowledges that the claims not allowed in the December 5, 2003 office action may require additional searching, but steadfastly asserts that the previously allowed claims have been searched and found to be recite patentable subject matter. For this reason, applicant respectfully submits that the second criterion for requiring restriction, at least in connection with claims 1-11, 19, 22, 32, 34 and 36-50, has not been satisfied.

The applicant therefore traverses the restriction requirement on the grounds that the minimum standard for requiring a proper restriction set forth in MPEP §803 has not been satisfied. The restriction requirement must be withdrawn and all claims 1-55 searched and examined in the present application.

II. THE EFFECT OF IMPROPERLY UPHOLDING THE NEW RESTRICTION REQUIREMENT

The effect of the Patent Office upholding the improper restriction requirement is that the Patent Office admits that the claims of Group I are patentably distinct over

the claims of Group II. MPEP §802.01 states that distinctness for a restriction requirement means that two or more subjects as claimed "ARE PATENTABLE (novel and unobvious) OVER EACH OTHER" (emphasis in original). The effect of upholding the restriction requirement is that the Patent Office admits that the claims of Groups I are patentable over any disclosure of the claims of Group II.

This position is necessary for the entry of the restriction requirement by the Patent Office. Thus, if the restriction requirement is upheld, the applicants can and will rely upon this position during examination of this application and any continuing or divisional applications. If this position is not to be taken by the Patent Office, then the applicants request that the restriction requirement be withdrawn.

III. PROVISIONAL ELECTION OF GROUP I

The restriction requirement is set forth between the claims of Group I (claims 1-11 and 36-50, "drawn to a method (of anchoring)") and Group II (claims 12-35, and 51-55, "drawn to an intermediate anchor system"). The applicants *provisionally elect*, as required for a complete response, claims 1-11 and 36-50 of Group I. However, the applicants make this provisional election *with traverse* in accordance with the foregoing remarks.

IV. CONCLUSION

For these foregoing reasons, applicant submits that the pending restriction requirement is improper and must be withdrawn. Further applicant submits that all of claims 1-55, and particularly the acknowledged and allowed claims 1-11, 19, 22, 32, 34 and 36-50, are in condition for allowance. If there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855 (27855/36740). Reconsideration and withdrawal of the restriction requirement is therefore respectfully requested.

Respectfully submitted for,

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